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10/070,936	08/09/2002	Jutta Glock	PH/5-31140A	4690

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SYNGENTA CROP PROTECTION, INC.  
PATENT AND TRADEMARK DEPARTMENT  
410 SWING ROAD  
GREENSBORO, NC 27409

EXAMINER
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QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/070,936

Applicant(s)

GLOCK ET AL.

Examiner

Sabiha Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**Non-Final Office Action**

Claims 1-17 are pending. No claim is allowed at this time. Amendments are entered.

**Summary of this Office Action Friday, August 31, 2007**

1. Continued Examination under 37 CFR 1.114
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. 35 USC § 112 --- First Paragraph written Description Rejection
6. 35 USC § 103(a) Obviousness Rejection – First Rejection
7. 35 USC § 103(a) Obviousness Rejection – Second Rejection
8. Response to Remarks
9. Communication

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/7/2007 has been entered.

**Information Disclosure Statement**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

**Copending Applications**

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

### **Specification**

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### **Claim Rejections - 35 USC § 112—Written Description Rejection**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Following reasons apply.

No synergism has been disclosed in the specification, which has been claimed. Applicant had no possession at the time this application was filed of claimed. The specification discloses the combination of compound 1.008 (one compound from formula (I) and cloquitocet-mexyl with tralkoxydim, fenoxaprop-ethyl and trisulfuron (see tables B2.1 to B2.4 on pages 43 and 44 in specification). The compounds of (b) as in claim 1 contains compounds having variety of different structures, which surely are expected to react differently. The prediction of synergism for the combination such a large number of compounds (b) having different properties and compound of formula (I) is therefore impossible.

**combinations such as COMBINATION OF COMPOUND 1.008 AND CLOQUITOCET-MEXYL, Tralkoxydim, fenoxaprop-ethyl and trisulfuron (pages 43 and 44 in the specification Tables B2.1 to B2.4 with oil additive MERGE) does not possess for the combination of all the various classes of herbicides for example classes of compounds include pyrimidines, triazines, "as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop" and many others.**

Compound of formula (I) itself include very large number of compounds due to variety of substituents defined by G, R<sub>1</sub> and R<sub>2</sub>. The compounds represented by the

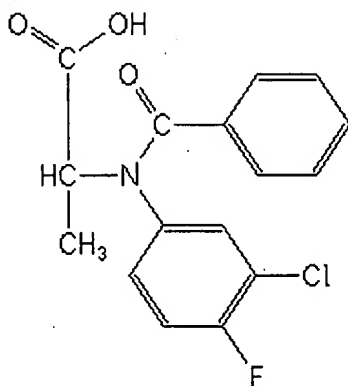
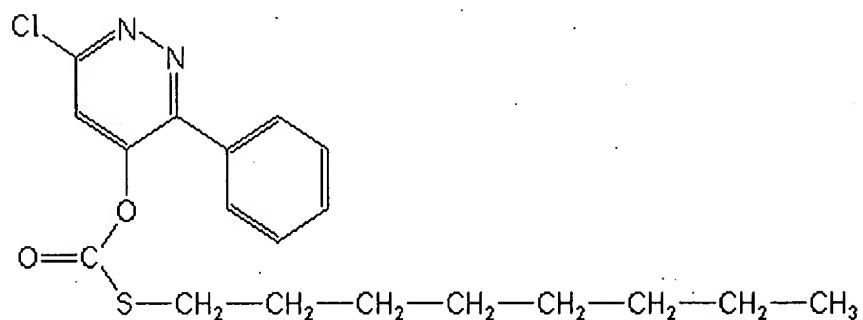
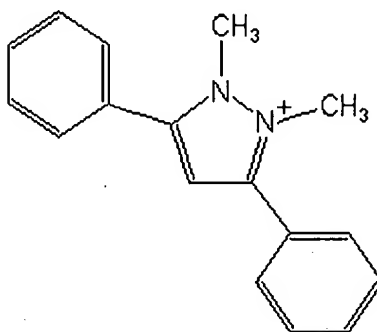
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formula (I) in claim 1 contain large number of compounds, and combination of (b) such as a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates,azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop.

The compounds of formula I itself includes thousands of compounds and their combination with the multitude of different classes of herbicides which can be selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates,azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop. These classes are so different from each other; it is impossible to predict any SYNERGISTIC activity for such compounds..

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For example, the three structures shown below belong to extremely different class of chemical compounds.

**flamprop****pyridate**



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**difenzoquat**

There is no guidance in the disclosure on how THE INVENTION CAN BE USED TO PREDICT THE SYNERGISM FOR LARGE CLASSES OF HERBICIDES successfully. **There is no teaching or data to show that combination of the compounds of formula 1 with all the various classes of herbicides listed in part b) of claim 1.<sup>1</sup>**

Applicant is kindly requested to show that at the time of invention Applicants were in possession of the claimed invention

**The written description requirement prevents applications from using the amendment process to update the disclosure in their disclosures (claims or specification) during the pendency before the patent office. Otherwise applicants could add new matter to their disclosures and date them back to their original filing date, thus defeating an accurate accounting of the priority of the invention. See 35 USC 132. The function of description requirement is to ensure that the inventor had possession, as of filing date of the application relied on, the specific subject matter claimed by him.**

See *Genetech*, 108 F 3d 1361, 1365 (Fed. Cir. at 1366, 78, 1999).

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<sup>1</sup> Examiner notes that Applicants in the specification disclose that "a specific safener will often be suitable only for a specific action with respect not only to the cultivated plants but also to the herbicide, and in some cases also subject to the mode of application, i.e. a specific safener will often be suitable only for a specific cultivated plant and a specific class of herbicide. See paragraph 3 on page 1 of the specification.

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The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to one skilled in the art that the inventor had the possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. See *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

See MPEP 2163.06, for Applicant convenience relevant portion is as follows:

#### **GENERAL PRINCIPLES GOVERNING COMPLIANCE WITH THE "WRITTEN DESCRIPTION" REQUIREMENT FOR APPLICATIONS**

The first paragraph of 35 U.S.C. 112 requires that the "specification shall contain a written description of the invention \* \* \*." This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). >See also *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1890-93 (Fed. Cir. 2004) (discussing history and purpose of the written description requirement); *In re Curtis*, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) ("conclusive evidence of a claim's enablement is not equally conclusive of that claim's satisfactory written description").< The written description requirement has several policy objectives. "[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information

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that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). The written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969-70, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002). Much of the written description case law addresses whether the specification as originally filed supports claims not originally in the application. The issue raised in the cases is most often phrased as whether the original application provides "adequate support" for the claims at issue or whether the material added to the specification

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incorporates "new matter" in violation of 35 U.S.C. 132. The "written description" question similarly arises in the interference context, where the issue is whether the specification of one party to the interference can support the newly added claims corresponding to the count at issue, i.e., whether that party can "make the claim" corresponding to the interference count. See, e.g., *Martin v. Mayer*, 823 F.2d 500, 503, 3 USPQ2d 1333, 1335 (Fed. Cir. 1987). In addition, early opinions suggest the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint was rejected. See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description); accord *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973); accord *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. These early opinions did not address the quality or specificity of particularity that was required in the description, i.e., how much description is enough.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of

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an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it"). "Compliance with the written description requirement is essentially a fact-based inquiry that will 'necessarily vary depending on the nature of the invention claimed.'" *Enzo Biochem*, \*\*>323 F.3d at 963<, 63 USPQ2d at 1613.

### **35 USC § 103(a) Obviousness Rejection – 1<sup>st</sup> Rejection**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over MUHLEBACH et al.<sup>2</sup> The reference teaches 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives as herbicides in particular in combination with herbicide-antagonistically effective compounds which embraces presently claimed invention. The reference also teaches the use of oil in composition, it may be natural in origin or mineral. See especially page 17 for oils and surfactants.

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The instant invention is drawn to a selective herbicidal composition comprising (a) herbicidally effective amount of a compound of Formula I and (b) a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates, azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlorypyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlfosinate and flamprop.

Instant claims differ from the reference in claiming a synergistic and broader combination of compounds than the prior art.

Therefore, it would have been obvious to one skilled in the art at the time invention was made to prepare additional beneficial composition because prior art teaches the combination of the structurally similar 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives of formula I and other "herbicide-antagonistically effective compounds". Claimed invention also claims the combination of the compounds of formula (I) and at least one safener and/or herbicide. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the

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<sup>2</sup> WO 99/47525. See the entire document especially abstract, compound of formula (I) on page 1, when R4 and R5 form together (Z2), examples and Tables (especially Tables 7 and 8).

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prior art. *In re Kerkhoven*, 205 USPQ 1069.

Since synergism cannot be predicted for such a large number of combinations of compounds and the specification does not disclose any direction for the expectation of synergism, instant invention is considered obvious over the prior art.

Furthermore, because of each compound appears to be well known in the prior art, it would appear that the combination of the compounds would have been obvious in view of MPEP 2144.06 and see *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

See *Ex parte Quadranti* where it was held that

"Use of materials in combination, each of which is known to function for intended purpose, is generally held to be prima facie obvious, and in instant case, use of combination of herbicides is so notoriously well known as to be capable of being taken by official notice; generalizations such as Colby formula are not particularly useful in determining whether synergism has been demonstrated, since formula inherently results in expectation of less than additive effect for combination of herbicides, since there is no evidence that such approach is considered valid by significant number of ordinarily skilled workers in relevant area of technology, and since it could be reasonably argued that in most cases, additive or better than additive results could be expected for combination of herbicides."

"There is no single, appropriate test for determining whether synergism has been demonstrated for chemical combination; rather, facts shown in each case must be analyzed to determine whether chosen method has clearly and convincingly demonstrated existence of synergism or unobvious result".

"Assuming arguendo that the differences in values presented are statistically significant, there is no evidence that they represent a true, practical advantage. *In re Freeman*, 474 F.2d 1318, 177 USPQ 139 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); *In re D'Ancicco*, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971). Also, prescinding from the Colby formula test, which as we have already indicated is at best



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controversial and in our view probably invalid, there is no evidence that the differences are unexpected. In re Merck, 800 F.2d 1091, 231 USPQ 375 (Fed.Cir. 1986); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed.Cir. 1985); In re Freeman, supra".

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

### **35 USC § 103(a) Obviousness Rejection – 2<sup>nd</sup> Rejection**

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over MUHLEBACH et al. in view of HAZEN et al.<sup>3</sup> The reference MUHLEBACH teaches 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives as herbicides in particular in combination with herbicide-antagonistically effective compounds which embraces presently claimed invention. The reference also teaches the use of oil in composition, it may be natural in origin or mineral. See especially page 17 for oils and surfactants.

The instant invention is drawn to a selective herbicidal composition comprising (a) herbicidally effective amount of a compound of Formula I and (b) a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates,azole-ureas, benzoic acids, anilides,

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nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop.

The MUHLEBACH teaches the composition that has been claimed and also use of oil additives except that combination of oil additives increases the herbicidal action<sup>4</sup>.

HAZEN et al. teaches that addition of oil in composition increases the herbicidal activity (abstract). It teaches that certain crop oil concentrates enhance the activity of a broad spectrum of herbicides to an unexpected high level. Furthermore, it teaches these "same crop oil concentrates surprisingly defeat the antagonism which is often created when two or more herbicides are utilized simultaneously" (lines 58-63 in col. 1). See lines 31-57 in column 4, lines 58-65 in col. 4., the abstract, tables especially tables IX and XI and examples 1-3 in col. 4.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time of invention was made to modify the composition of MUHLEBACH to include the additive oils as taught by HAZEN because there is a motivation to obtain enhanced herbicidal activity by adding oils. MUHLEBACH teaches the combination of the structurally similar 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives of formula I and other "herbicide-antagonistically effective compounds". One having ordinary skill in the art would have been motivated to add oil in the composition to enhance the herbicidal

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<sup>3</sup> US Patent 4,834,908, see abstract, lines 58-63 in column 1; lines 1-2 in col. 1; lines 1-68 in col. 3 examples 1-3 lines 35-68 in col. 3.

<sup>4</sup> Even though the addition of oil has not been cited in the claims this has been addressed (Hazen et al) because the specification of present invention discloses the use of oil for increasing the herbicidal action.

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activity because this modification would have been obvious. (See especially abstract in Hanzel). It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 205 USPQ 1069.

Since synergism cannot be predicted for such a large number of combinations of compounds and the specification does not disclose any direction for the expectation of synergism, instant invention is considered obvious over the prior art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality and/or unexpected results presently claimed invention would have been *prima facie* obvious to one skilled in the art.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

**Response to Remarks**

- Double Patenting rejection over claims 14-18 of U.S. Patent No. 6,410,480 is withdrawn because Terminal disclaimer has been filed and approved.
- Declaration was fully considered but was not found persuasive because first, synergism was not found in the data disclosed in the declaration; second, it does not commensurate with the scope of claims. Declaration of each combination was discussed in a personal interview with Attorney Jacqueline Haley on 8/27/2007. Rejections are maintained for the same reasons as set forth in the previous office action.

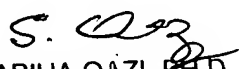
**Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, Ph.D. can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SABIHA QAZI, PH.D.  
PRIMARY EXAMINER